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Serial No. 09/872,859

REMARKS/ARGUMENTS

The Office Action mailed July 28, 2005, has been received and reviewed. Claims 2-11, 21-26, 28, 29 and 31 are currently pending in the application. Claims 2-11, 21-26, 28, 29 and 31 stand rejected. Applicants respectfully request reconsideration of the application in view of the remarks set forth below.

Drawings

Applicants note that the new drawings submitted on October 30, 2001, as part of a Reply to Notice of Incomplete Reply, have not been acknowledged in the present Office Action. Applicants respectfully request approval of the drawings.

35 U.S.C. § 102(b) Anticipation Rejections**Anticipation Rejection Based on International Patent Publication No. WO 00/22543 to Hong**

Claims 2, 3, 21, 28, 29 and 31 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hong (WO 00/22543). Applicants respectfully traverse this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Turning to the cited reference, Hong is directed to a method and system for interrogating the Internet to identify a server to which a user at a remote location belongs. A system embodied by Hong is described as including a remote access mail client 1 that, in conjunction with a dynamic access database 2, allows a user at a remote computer 6 to identify and contact an electronic mail server 8 storing the user's e-mail (pp. 6-7). The client 1 also has Internet access to the DNS database 3, the WHOIS server 4 and the POP3/IMAP4 search engine 5 (Figure 1).

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According to the method described in Hong, a user first logs into an ISP at computer 6 and then accesses client 1 via a browser 7 (pp. 7-8). The user enters their electronic mail address and log-in password, and client 1 initiates a sequence of actions to identify the user's server from the information provided. In a first stage of a first phase, client 1 parses the electronic mail address to obtain a presumed domain name by stripping out the user identity (p. 8). Client 1 then interrogates access database 2 to determine whether there is a user record indicating the user's server (Figure 2, Table T1) or a domain record that corresponds to the presumed domain name (Figure 2, Table T2). If there is such a record, the user's details are sent to the identified server to retrieve the user's mail (p. 8).

In a second stage of the first phase, client 1 assumes that the domain name is the user's server and checks the domain for the user's mail (p. 9). If there is a negative response from the domain name, client 1 sends out a DNS inquiry to check for the MX record. For each response from DNS database 3, port 110 and/or 143 of that server is checked to see if they are open or closed. The user's information is then sent to any server in the list of responses found to have one of these ports open, and any successful response is written into the access database 2.

If the first phase of the method fails to identify the user's server, client 1 initiates a first stage of a second phase of the method by obtaining the IP address of the MX record and checking to see if the mail protocol ports associated with IP addresses 2-254 are open or closed (p. 9). All IP addresses with open ports are subsequently checked for the user's mail. If the enumeration of IP addresses fails to identify the user's server, client 1 initiates a second stage of the second phase, in which the entire list of names CANME and/or HOST is requested for the presumed domain name by zone transfer from the DNS database 3 (p. 10). Again, the host names are checked for open port status, and the host names having an open port are checked for the user's mail.

If the second phase fails to identify the user's server, client 1 initiates a third and final phase by retrieving from the WHOIS server the IP address block which has been allocated to the domain organization or company and scanning the addresses in the block for open ports (p. 10). All addresses having open port status are used to check for the user's mail.

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Applicants respectfully submit that the above-described system and method of Hong fail to disclose, either expressly or inherently, all of the elements recited in claims 2, 3, 21, 28, 29 and 31.

Claim 2 recites *inter alia* the limitation "wherein the step of determining whether the electronic mail account domain, user name and password can be used to access the electronic mail account according to the electronic mail protocol includes determining if the electronic mail account domain is included in *a list of closed domains that do not include server computers employing the electronic mail protocol.*" (Emphasis added.) Likewise, claim 28 recites the limitation "wherein the server mapper is configured to compare the domain with *a list of closed domains that do not include server computers employing the electronic mail protocol.*" (Emphasis added.)

Among other things, Hong fails to disclose the concept of consulting a list of closed domains that do not include server computers employing the electronic mail protocol, as recited in the context of the present claims. In the instant rejection, the Office asserts Hong teaches this limitation at page 2, ¶ 4, page 6 and page 10, ¶ 3, when describing the storage of accessed domains for future reference in the access database 2 (Office Action, p. 3). Applicants respectfully submit that the Office has mischaracterized the disclosure of Hong.

As discussed above, Hong describes obtaining DNS responses, IP addresses or host names associated with a domain name, and checking the corresponding servers for open mail ports (p. 2, ¶ 4 – p. 3 ¶ 3). Those locations are then checked for a user's mail and, based on this query, "a record of any successful response is written into the access database 2." (p. 9, ¶ 3). (See also, p. 9, ¶ 4 and p. 10, ¶¶ 1-2: "host names having open port status are written into the access database 2"; "a record of any successful host being written into the access database 2.") Accordingly, Hong merely teaches scanning ports 110 and 143 of servers to see if they are open, and then storing a list of names having open ports in access database 2. At no point does this involve using a list of closed domains as recited in the context of the present claims.

Claim 21 recites *inter alia* the limitations of "concatenating a server name prefix with the electronic mail account domain to form a default name for a server computer" and "attempting to access the electronic mail account according to the electronic mail protocol by using the default

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name, the user name and the password." Likewise, claim 31 recites the limitation of "a host name generator for concatenating a server name prefix with the electronic mail account domain to form a default name for a server computer."

It is noted that the Office does not address either of these limitations in the instant rejection of claims 21 and 31 under 35 U.S.C. § 102(b). In fact, in the subsequent rejections under 35 U.S.C. § 103(a), the Office acknowledges that that Hong does not teach "adding mail, pop, pop3 to the domain name," but takes "Official Notice" that it is well known in the art to use these as prefixes for a mail server domain name. (Office Action, p. 5.) As an assertion of obviousness is not proper in a rejection under 35 U.S.C. § 102(b), Applicants with limit the present argument to concurring with the Office that the above-described limitations of claims 21 and 31 are not disclosed by Hong, and will present arguments regarding obviousness below.

In view of the foregoing, Applicants respectfully submit that Hong fails to disclose all of the elements of claims 2, 21, 28, and 31, which are allowable under the provisions of 35 U.S.C. § 102(b). Claims 3 and 29, which respectively depend from and incorporate the limitations of claims 2 and 28, are also allowable.

35 U.S.C. § 103(a) Obviousness Rejections**Obviousness Rejection Based on International Patent Publication No. WO 00/22543 to Hong in View of "Official Notice"**

Claims 4-11 and 22-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hong in view of "Official Notice" taken by the Examiner. Applicants respectfully traverse this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on

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applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The 35 U.S.C. § 103(a) obviousness rejections of claims 4-11 and 22-26 are improper because they fail to establish a *prima facie* case of obviousness.

Claims 4-11 and 24-26 depend from amended claim 2. Claim 2 recites *inter alia* the limitation "wherein the step of determining whether the electronic mail account domain, user name and password can be used to access the electronic mail account according to the electronic mail protocol includes determining if the electronic mail account domain is included in a list of closed domains that do not include server computers employing the electronic mail protocol." (Emphasis added.)

As previously discussed above, Hong fails to disclose these limitations. Accordingly, claim 2 is allowable under the provisions of 35 U.S.C. § 103(a). Claims 4-11 and 24-26, which depend from claim 2, are also allowable. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

With respect to claims 22 and 23, the Office acknowledges that Hong does not teach "adding mail, pop, pop3 to the domain name," but takes "Official Notice" that it is well known in the art to use these as prefixes for a mail server domain name. (Office Action, p. 5.) Applicants respectfully submit that it is not common knowledge or well known in the art to concatenate a prefix with an electronic mail account domain to form a default name for a server as recited in the context of claims 21 and 31, e.g., in the context of determining information needed to access an electronic mail account based on an address for the electronic mail account.

Accordingly, Applicants submit that claims 22 and 23 are allowable under the provisions of 35 U.S.C. § 103(a). If the Office maintains the present rejection, Applicants demand specific evidence be provided to support the Examiner's statement of official notice, as required by MPEP 2144.03.

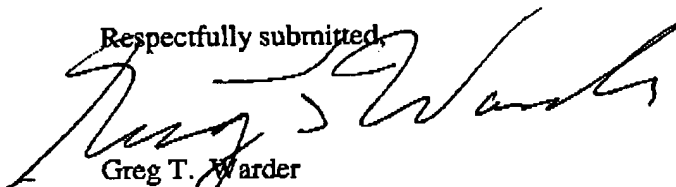
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CONCLUSION

Claims 2-11, 21-26, 28, 29, and 31 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,



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